

### **DETAILED ACTION**

Applicant's amendment and Declaration filed on 3/20/08 are acknowledged.

The previous 112, 1<sup>st</sup> rejection is hereby withdrawn due to Applicant's amendment in claim 1 by adding the specific species of the plant in Cucurbitaceae.

The previous 101 rejection is withdrawn due to Applicant's amendment by deleting "prevent" and "prevention" in claims 2 and 12.

The Declaration under 37 CFR 1.132 filed on 3/20/08 is sufficient to overcome the 103 rejection of claims 1, 2 and 4-14 based upon JP 59203451 in view Tang et al.

### **Claims Pending**

Claim 3 is cancelled. Claims 1, 2, and 4-14 are pending. Claims 1, 2, and 4-14 are examined on the merits.

### **Double Patenting Rejection**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 2 and 4-14 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/581,576.

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 9/20/2007, repeated below. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

Applicant request the above rejection is held in abeyance until the claims of copending Application No. 10/581,576 are examined and are in condition for allowance.

### **Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 4-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 9/20/2007, repeated below. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

Applicant argues that "A claim does not have to recite each and every step in a process if the omitted steps are common knowledge to a person skilled in the art. The parameters of silica

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gel column chromatography (e.g., flow rate; solvent mixture; column diameter and length; bead size, composition and manufacturer) are routinely determined for each experiment or isolation procedure. A skilled person in the art can easily obtain the 11 sub-fractions based on the teachings of the subject specification and technical knowledge generally established in the art” (page 6, last paragraph). Applicant also argues that “The Specification gives examples of the parameters selected for a silica gel column chromatography to isolate the disclosed compound. See for example: Page 9, paragraph 2; and Page 16, Example 6. Preparation of purified cmc-9 extract” (page 7, 1<sup>st</sup> paragraph). Applicant further argues that “Additionally, the flow rate and the amount of solvent used as an eluent is conventionally determined depending on the amount of a resin filled in a column according to the amount of a sample to be loaded, as disclosed in *Microscale organic laboratory with multistep and multiscale syntheses*, Dana W. Mayo, Ronald M. Pike, Peter K. Trumper, 3<sup>rd</sup> edition, John Wiley & Sons” (page 7, 2<sup>nd</sup> paragraph). Applicant argues that Further, it is obvious that several fractions can be separated in a TLC pattern by a conventional silica gel chromatography as disclosed in the Examples of the subject specification, and then the fraction showing most potent anti-adipogenic and anti-obesity activity (i.e., 9<sup>th</sup> fraction) can be selected among the separated fractions through *in vitro* bioassay (i.e., adipocyte differentiation) (page 7, 3<sup>rd</sup> paragraph).

This is not found persuasive. Applicant is not required to recite each and every step of the process. However, Since Applicant claims the 9th of 11 sub-fractions has active ingredient in treatment of adipogenesis-involved disease, it is crucial for Applicant to recite the experimental condition, such as flow rate, and amount of solvent, in the claim language. Otherwise, one of the ordinary skills in the art would not be able to obtain the same results as claimed. For instance,

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when the total volume of solvent is 220 ml, 20 ml of solvent is collected for each sub-fraction, the components in the 9<sup>th</sup> fraction would be different from the components of the 9<sup>th</sup> fraction when the total volume of solvent is 110 ml, and 10 ml of solvent is collected for each sub-fraction. Therefore, the metes and bounds of claims are rendered vague and indefinite. The lack of clarity renders the claims very confusing and ambiguous since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired. In addition, it is noted that the features upon which applicant relies (i.e., example 6 of the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments have been fully considered but they are not persuasive, and therefore the rejection in the record are maintained.

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### Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QM

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/Patricia Leith/

Primary Examiner, Art Unit 1655